

REMARKS

The Office Action has imposed a Restriction Requirements under 35 U.S.C. §121.

More specifically, it has divided the claimed subject matter to the following subgenera:

G1: R is hydrogen or lower alkyl, and R is substituted;

G2: R is hydrogen or lower alkyl, and R is unsubstituted;

G3: R1 is hydrogen or lower alkyl, and R1 is substituted;

G4: R1 is hydrogen or lower alkyl, and R1 is unsubstituted;

G5: the substituents can vary as the claims permit, provided that G1-G4 are excluded;

G6: the disorder can be whatever is permitted by claim 50, provided that G6 is excluded.

The Office Action then imposed a Restriction Requirement under 35 U.S.C. §121, requiring applicant to elect one of the following groups for examination:

1. Claims 1-4, 6-8, 11-13, 15-19, 51, 55, 58, drawn to a method, limited to compounds in which R is limited to G1.

2. Claims 1-4, 6-8, 11-13, 15-19, 51, 55, 58, drawn to a method, limited to compounds in which R is limited to G2.

3. Claims 1-4, 6-8, 11-13, 15-19, 51, 55, 58 drawn to a method, limited to compounds in which R1 is limited to G3.

4. Claims 1-19, 51, 55, 58, drawn to a method, limited to compounds in which R1 is limited to G4.

5. Claims 1-4, 6-8, 11-13, 15-19, 51, 55, 58 drawn to a method, limited to G5.

6. Claims 20-23, 25-27, 29-31, 34, 52, 56, 59-67, drawn to a method, limited to compounds in which R is limited to G1.

7. Claims 20-23, 25-27, 29-31, 34, 52, 56, 59-67, drawn to a method, limited to compounds in which R is limited to G2.
8. Claims 20-23, 25-27, 29-31, 34, 52, 56, 59-67, drawn to a method, limited to compounds in which R1 is limited to G3.
9. Claims 20-34, 52, 56, 59-67, drawn to a method, limited to compounds in which R1 is limited to G4.
10. Claims 20-23, 25-27, 29-31, 34, 52, 56, 59-67, drawn to a method, limited to G5.
11. Claims 35-38, 40-42, 44-46, 49, 53, 57, 68-72, drawn to a method, limited to compounds in which R is limited to G1.
12. Claims 35-38, 40-42, 44-46, 49, 53, 57, 68-72, drawn to a method, limited to compounds in which R is limited to G2.
13. Claims 35-38, 40-42, 44-46, 49, 53, 57, 68-72, drawn to a method, limited to compounds in which R1 is limited to G3.
14. Claims 35-49, 53, 57, 68-72, drawn to a method, limited to compounds in which R1 is limited to G4.
15. Claims 35-38, 40-42, 44-46, 49, 53, 57, 68-72, drawn to a method, limited to G5.
16. Claims 50 and 54, drawn to a method of G6, wherein the method of G6 is limited to compounds in which R is limited to G1.
17. Claims 50 and 54, drawn to the method of G6, wherein the method of G6 is limited to compounds in which R is limited to G2.

18. Claims 50 and 54, drawn to the method of G6, wherein the method of G6 is limited to compounds in which R1 is limited to G3.

19. Claims 50 and 54, drawn to the method of G6, wherein the method of G6 is limited to compounds in which R1 is limited to G4.

20. Claims 50 and 54, drawn to the method of G6, wherein the method of G6 is limited to compound that are limited to G5.

21. Claims 50 and 54, drawn to the method of G7, wherein the method of G7 is limited to compounds in which R is limited to G1.

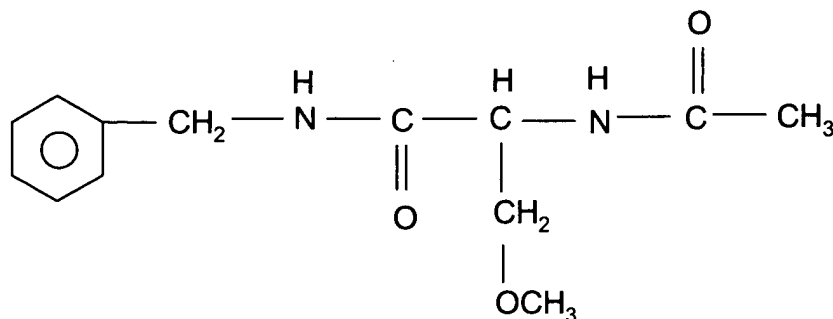
22. Claims 50 and 54, drawn to the method of G7, wherein the method of G7 is limited to compounds in which R is limited to G2.

23. Claims 50 and 54, drawn to the method of G7, wherein the method of G7 is limited to compounds in which R1 is limited to G3.

24. Claims 50 and 54, drawn to the method of G7, wherein the method of G7 is limited to compounds in which R1 is limited to G4.

25. Claims 50 and 54, drawn to the method of G7, wherein the method of G7 is limited to compound that are limited to G5.

In order to be responsive to the Restriction Requirement imposed by the Office Action, applicant elects Group 4, i.e., Claims 1-19, 51, 55 and 58, drawn to a method but limited to compounds in which R1 is limited to G4 as defined. Moreover, in response to the Office Actions, applicants elect the species (R)-N-Benzyl-2-acetamido-3-methoxy propionamide which has the following structure:



i.e.,

R is benzyl, R₂ is hydrogen, R₃ is methoxymethyl, R₁ is methyl and n is 1.

Furthermore, applicant has amended the claims to correct typographical errors thereon. More specifically, Claim 58 has been amended to correct the structural formula, consistent with the structures on Page 26, Line 26 wherein R₃ is CH₂Q. In addition, Claims 59-62 have been amended to make them dependent on Claim 58.

No new matter has been added to the application.

Further, to be responsive to the requirement in the Office Action, applicant submits that the following claims are readable on the elected species:

Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 14, 15, 16, 17, 18, 19, 51, 56, 58, 59, 60, 61 and 62.

Nevertheless, applicant reserves the right to file a divisional application directed to the non-elected subject matter.

However, applicant hereby traverses the Examiner's requirement for restriction and request reconsideration in view of the following Remarks.

Applicant respectfully submits that the Restriction Requirement is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141-1.142. 35 U.S.C. §121 provides that the Commissioner may restrict an application when "two or more independent and distinct invention

are claimed in a single application.” (Emphasis added). Similarly, 37 C.F.R. §1.41(a) permits restriction conditioned upon a finding that independent and distinct inventions are found within one application.

The Office Action has failed to comply with the statutory and regulatory requirements in imposing the Restriction Requirement. The Office Action has not shown that the application contains two or more independent and distinct invention, as required by 35 U.S.C. §121. In fact, it has not even alleged that the various groups are independent and distinct, as required by 35 U.S.C. §121 and 37 C.F.R. §§1.141-1.142. Thus, the Office Action has not made out a prima facie case to support the restriction requirement imposed. Therefore, the restriction requirement is improper and applicant respectfully requests that it be withdrawn.

Moreover, it is also noted that the Restriction Requirement is not in compliance with MPEP §808. MPEP §808 states:

Every requirement to restrict has two aspects: (a) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct and (b) the reasons for insisting upon restriction therebetween.

The Office Action merely concludes that the groups are patentably distinct. It did not provide any reasons why the groups are patentably distinct. In addition, it has not provided any reasons for insisting upon restriction therebetween. Since the United States Patent and Trademark Office must comply with the MPEP, its failure to do so provides an additional basis for the impropriety of the restriction requirement.

In conclusion, the Office Action has not complied with the statute, regulations or the MPEP. Therefore, applicant respectfully submits that the Restriction Requirement be

withdrawn and that the United States Patent and Trademark Office examine all of the claims in the pending application.

Moreover, it is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that 35 U.S.C. §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee’s rights and to serve the public’s interest in the legitimacy of issued patents, applicants respectfully urge the Examiner not to require an election of species requirement in support of a restriction requirement

in cases such as the present application wherein various aspects of a unitary invention are claimed.

In addition, the Courts have recognized the advantages to the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention.

The CCPA has observed:

We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects of what they regard as their invention, regardless of the number of statutory classes involved. (Emphasis added).

In re Kuehl, 456, F.2d 658, 666, 177 USPQ 250, (CCPA 1973).

Furthermore, applicant respectfully requests that in view of increased Official Fees and the potential limitation of applicant's financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive, and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts.

Hence, it is respectfully requested that the Examiner withdraw the Restriction Requirement, and provide an action on the merits with respect to all of the claims.

Respectfully submitted,



Peter I. Bernstein

Registration No. 43,497

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530-0299
(516) 742-4343

MJC/PIB:lf/dg